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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,508	01/20/2004	Todomu Nishino	09483/0200797-US0	4227
7278	7590	05/27/2005	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			RAYFORD, SANDRA M	
			ART UNIT	PAPER NUMBER
			1772	
DATE MAILED: 05/27/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/761,508	NISHINO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sandra M. Nolan	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 22-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☒ Claim(s) 1-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

*S.M. Nolan - Royford 5-25-05*

*u*

## **DETAILED ACTION**

### ***Claims***

1. Claims 1-26 are pending, with claims 1-21 are treated here.  
Claims 22-26 are withdrawn as non-elected.

### ***Amendment***

2. Applicants have submitted a 10 March 2005 responsive amendment ("the last response") in reply to the 14 December 2004 office action ("the last office action").

### ***Election/Restrictions***

3. This application contains claims 22-26 drawn to an invention nonelected with traverse in the 03 December 2004 reply.

A complete reply to this final requirement must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***New Objection***

#### **Claim Objection**

4. Claims 1-21 are objected to because of the following informalities:

The language that describes the properties exhibited by the polyester-based elastomer, in lines 2-5 of the claim, is indefinite.

What do applicants mean by "a . . . performance test"?

It is impossible to determine the scope of a claim when it does not properly recite the limitations to be met when infringing it.

Art Unit: 1772

Also, one of ordinary skill cannot practice the invention if all that s/he knows is that the polyester used to make the tubes is a polyester-based elastomer that meets some undefined tests.

Lastly, it is impossible to meaningfully understand the nature of the polyesters being used if all that defines them is the term "elastomer" and a series of test, each of which is designated as "a . . . performance test"

Appropriate correction is required.

***Objections Withdrawn***

5. The objections to claims 3 and 2-21, stated in sections 3 and 4 of the last office action, have been overcome by the amendments in the last response.

***Rejections Withdrawn***

6. The 35 USC 112 rejection of claims 2, 7, and 12 for indefiniteness, set out in section 9 of the last office action, is withdrawn in view of the arguments set out in the last response.

***Rejections Maintained***

7. The obviousness-type double patenting rejection, set out in section 7 of the last office action, is maintained for reasons of record.

Pursuant to MPEP 822.01, the examiner is to maintain this rejection unless it is the only rejection remaining in the case.

8. The 35 USC 103 rejection of claims 1-2 as unpatentable over Ozawa et al (US-5,380,571), set out in section 12 of the last office action, is maintained for reasons of record.

Art Unit: 1772

9. The 35 USC 103 rejection of claims 1-15 as unpatentable over Kertesz (US 6,294,234), set out in section 13 of the last office action, is maintained for reasons of record.

10. The 35 USC 103 rejection of claims 16-21 as unpatentable over Kertesz in view of Ostrander (US 5,960,977), set out in section 14 of the last office action, is maintained for reasons of record.

### ***Response to Arguments***

11. Applicant's arguments filed in the last response have been fully considered but they are not persuasive.

On page 6 of the response, applicants argue that the double patenting rejection should be withdrawn.

This argument is dealt with above.

On pages 8-9, applicants argue that Ozawa teaches outer layers that are not polyesters and that it does not teach the properties recited in their claim 1.

However, claims 1-2 recite a tube "comprising" a layer of polyester of a certain type. Since other layers can be present, Ozawa is suggestive of the claimed tubes.

Furthermore, the properties recited in claim 1 are the subject of a new objection. See above.

On pages 9-10, applicants argue that Kertesz does not teach the properties in claim 1 and that its tubes can be bent.

However, the new objection above discussed those properties and the claim's failure to present them in a meaningful way.

Art Unit: 1772

Also, the fact that Kertesz's tube can be bent is not a difference over the claims here. Tubes to be used for fuel in motor vehicles must be capable of being bent. Note that applicants' method claims call bending their tubes.

On page 10, applicants argue that the same arguments that relate to Kertesz as applied to claims 1, 3-5 and 13-16, apply when the rejection of claims 16-21 is considered.

However, those arguments are dealt with effectively above. They are not persuasive.

On pages 10-11, applicants argue that Ostrander teaches away from the invention because it shows conductive materials.

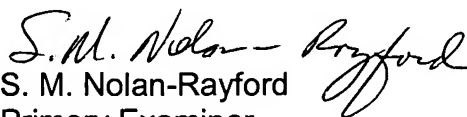
However, the claims depend on claim 3, which recites "comprises" [as does claim 1, from which it depends], so that claims 16-21 do not exclude Ostrander's materials.

### ***Conclusion***

Any inquiry concerning this communication should be addressed to Sandra M. Nolan-Rayford, at telephone number 571/272-1495. She can be reached Monday through Thursday, from 6:30 am to 4:00 pm, ET.

If attempts to reach the examiner are unsuccessful, contact her supervisor, Harold Pyon, at 571/272-1498.

The fax number for patent application documents is 703/872-9306.

  
S. M. Nolan-Rayford  
Primary Examiner  
Technology Center 1700

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